

REMARKS

Claims 22 and 24-42 are now present in this application. Claims 22, 41 and 42 are independent. By this Amendment, claim 42 is amended. No new matter is involved.

Reconsideration of this application, as amended, is respectfully requested.

Initially, Applicants thank the Examiner for allowing claims 22, 24-39 and 41. The allowance of claim 23 is considered to be a typographical error because claim 23 was canceled in the Amendment filed on December 14, 2010.

Apparent Withdrawal of Election by Previous Presentation

Because all pending claims have been treated on their merits, it appears that the previous restriction of claim 42 has been withdrawn, and the previous withdrawal of claim 42 from consideration on its merits has been revoked.

Premature Final Rejection

Because claim 42 is being examined for the first time on the merits in the outstanding Office Action, the outstanding Office Action has been improperly made a final Office Action.

Accordingly, withdrawal of the finality of the outstanding Office Action is respectfully requested.

Applicants respectfully submit that entry of this amendment is proper as a matter of right because the outstanding Office Action should be a non-final Office Action. It also should be entered because it merely makes the claim grammatically correct by changing the second occurrence in the wherein clause of "vertical" to - - vertebral - -. Additionally, Applicants note that the amendment to claim 42 makes it fully consistent with language in claim 22, line 5, and in claim 41, lines 9 and 10.

Rejections under 35 U.S.C. § 112, Second Paragraph

Claim 42 stands rejected under 35 U.S.C. § 112, second paragraph for being indefinite. In order to overcome this rejection, without narrowing the scope of the claims, the language "the devices for vertical fixation" has been changed to read - - the devices for vertebral fixation - -.

PCL/RJW/kml/la

Applicants respectfully submit that there is proper antecedent basis in claim 42, line 9 for the language "the open tail of the device for vertebral fixation" because lines 5 and 6 recite a device for vertebral fixation comprising a hook having an open tail.

Accordingly, reconsideration and withdrawal of this rejection are respectfully requested.

Rejections under 35 U.S.C. § 102

Claims 40 and 42 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 5,562,662 to Brumfield. This rejection is respectfully traversed.

A prior art reference anticipates the subject matter of a claim when that reference discloses every feature of the claimed invention, either explicitly or inherently. *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997) and *Hazani v. Int'l Trade Comm'n*, 126 F.3d 1473, 1477, 44 USPQ2d 1358, 1361 (Fed. Cir. 1997). While, of course, it is possible that it is inherent in the operation of the prior art device that a particular element operates as theorized by the Examiner, inherency may not be established by probabilities or possibilities. What is *inherent*, must necessarily be disclosed. *See In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981); *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993).

During patent examination the PTO bears the initial burden of presenting a *prima facie* case of unpatentability. *See In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). If the PTO fails to meet this burden, then the Applicants are entitled to the patent. However, when a *prima facie* case is made, the burden shifts to the Applicants to come forward with evidence and/or argument supporting patentability. Patentability *vel non* is then determined on the entirety of the record, by a preponderance of evidence and weight of argument, *In re Gulag*, 62 USPQ2d 1151 (Fed. Cir. 2002).

Moreover, as stated in MPEP § 707.07(d), where a claim is refused for any reason relating to the merits thereof it should be "rejected" and the ground of rejection fully and clearly stated.

Additionally, findings of fact and conclusions of law by the USPTO must be made in accordance with the Administrative Procedure Act, 5 U.S.C. §706(A), (E) (1994). *See Zurko v. Dickinson*, 527 U.S. 150, 158, 119 S.Ct. 1816, 1821, 50 USPQ2d 1930, 1934 (1999).

A claim limitation is inherent in the prior art if it is necessarily present in the prior art, not merely probably or possibly present. *See Rosco v. Mirro Lite*, 304 F.3d 1373, 1380, 64 USPQ2d 1676 (Fed. Cir. 2002). The dispositive question regarding anticipation is whether one skilled in the art would reasonably understand or infer from the prior reference's teaching that every claim feature or limitation was disclosed in that single reference, *Dayco Products, Inc. v. Total Containment, Inc.*, 329 F.3d 1358, 1368, 66 USPQ2d 1801 (Fed. Cir. 2003).

The rejection relies on Fig. 11 of Brumfield to anticipate the claimed invention.

However, Applicants respectfully submit that Brumfield's Fig. 11 does not disclose the combination of features recited in independent claim 42. For example, claim 42 recites a combination of features including a hook adapted to be fixed to the rod by attachment of an open tail of the hook directly to the rod.

In Brumfield's Fig. 11, hook 25 is attached to rod 21 using hook stem 26 (incorrectly indicated in the Office Action as "setscrew 26"), which does not constitute an open tail, as claimed. Brumfield's stem 26 clearly has no opening whatsoever. Moreover, Brumfield's hook stem 26 is not directly attached to rod 21. Instead, Brumfield's hook stem 26 is connected to rod 21 indirectly via a separate rod connector 29.

Moreover, claim 42 recites an open tail of a device for vertical fixation adapted to be attached to the rod and locked in place by a setscrew on the inside of the open tail and a locknut on the outside of the open tail. In Brumfield's Fig. 11, hooks 25 are clearly not directly attached to rod 21 by an open tail of hook 25, because the only tail of hook 25, i.e., hook stem 26 is clearly not open ended; and the hex recess setscrews 111 are only disclosed as fitting into separate rod connectors 29 rather than on the inside of an open tail of hook 25, and the only disclosed locknuts 124 are used not on any open tail, but on hook stem 26, and hook stem 26 is clearly not an open tail. Moreover hook stems 26 clearly are not directly connected to rod 21. Rather, hook stems 26 are attached directly to connectors 29 and only indirectly to rod 21 via connectors 29.

Accordingly, claim 42 is not anticipated by Brumfield.

Furthermore, with respect to claim 40, claim 40 depends from claim 42 and is not anticipated by the applied art at least because it includes the subject matter of claim 42. Additionally, Brumfield's hook stem 26 clearly does not have an opening adapted to receive the rod 21 inside of that opening. Instead, hook stem 26 has no opening whatsoever, let alone an opening adapted to receive rod 21 inside thereof. Accordingly, Brumfield does not anticipate the additional subject matter recited in claim 40.

Accordingly, the Office Action does not make out a *prima facie* case of anticipation of claims 40 and 42 by Brumfield.

Thus, reconsideration and withdrawal of this rejection of claims 40 and 42 are respectfully requested.

Conclusion

All of the stated grounds of rejection have been properly traversed, the finality of the Office Action has also been traversed, and Applicants respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone Robert J. Webster, Registration No. 46, 472, at (703) 205-8000, in the Washington, D.C. area.

Prompt and favorable consideration of this Amendment is respectfully requested.

Application No. 10/660,685
Amendment dated July 5, 2011
Reply to Office Action dated January 4, 2011

Docket No.: 2644-0105P
Page 11 of 11

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Dated: July 5, 2011

Respectfully submitted,

By 

Paul C. Lewis

Registration No.: 43,368

BIRCH, STEWART, KOLASCH & BIRCH, LLP

8110 Gatehouse Road

Suite 100 East

P.O. Box 747

Falls Church, Virginia 22040-0747

(703) 205-8000

Attorney for Applicants